mailed on April 2, 2002. Claims 1 - 12 are pending, and all stand rejected at present. Dependant claims 13 and 14 are added.

Response to Rejection of Claims 1 - 3, 5 - 9, 11, and 12

Claims 1 - 3, 5 - 9, 11, and 12 were rejected as obvious, based on Kramer and Walker.

Role Model Missing from Kramer

The Office Action asserts that Kramer shows the claimed "interactive advertising displays incorporating the one or more role models." However, the "one or more role models" are animated, human-like, anthropomorphic figures, which represent human role models which are appealing to the target customer of the advertising. The Specification also refers to them as "central characters," "virtual characters," and "virtual idols." (See, for example, page 6, lines 16 - 21; page 6, lines 26, 27; page 8, lines 5 - 12; and page 8, lines 26 - page 9, line 1.)

Applicant cannot locate such role models in Kramer, and requests, under 37 CFR §§ 1.104(b) and 1.106(b) and 35 U.S.C. § 132, that the PTO specifically identify the claimed role model incorporated into the interactive site.

In this connection, Applicant points out that added dependant claims 13 - 14 recite additional features of the role model.

Rejection is Defective

The Office Action, pages 3 and 4, makes a three-fold statement.

First, it purports to quote selected language from claim 1, and states that Kramer suggests that language.

Second, it sets forth the same quoted language, and states that Kramer "lacks an explicit recitation" of that claim language, but nevertheless suggests the language.

Third, it asserts that it is obvious to "select" "the disclosure of Kramer"

> because such selection would have provided a means that "overcomes the limitations of conventional models and targeting methods for delivering custom content to consumers that matches their interests, preferences, demographics, or psychographics."
>
> (Office Action, page 4, end of first full paragraph. The quoted language in the paragraph immediately above is taken from Kramer, column 2, lines 46 - 50.)

The Office Action then repeats this approach, but with a second purported quote from claim 1.

These dual approaches, each containing three steps, do not comply with section 103, and is ineffective as a rejection, for several reasons.

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REASON 1

One reason is that the rejection fails to set forth a proper

Deere analysis, which is outlined in MPEP § 706.02(j), which

states:

Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to
meet the claim, it is necessary to modify a
single reference or to combine it with one or
more other references.

After indicating that the rejection is under
35 U.S.C. 103, the examiner should set forth
in the Office action:

(A) the relevant teachings of the prior art
relied upon, preferably with reference to the
relevant column or page number(s) and line
number(s) where appropriate,

(B) the difference or differences in the claim
over the applied reference(s),

(C) the proposed modification of the applied
reference(s) necessary to arrive at the
claimed subject matter, and

(D) an explanation why one of ordinary skill
in the art at the time the invention was made
would have been motivated to make the proposed
modification.

To establish a prima facie case of
obviousness, three basic criteria must be met.
First, there must be some suggestion or
motivation, either in the references
themselves or in the knowledge generally
available to one of ordinary skill in the art,
to modify the reference or to combine
reference teachings.

Second, there must be a reasonable expectation

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of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

This <u>Deere</u> analysis is not present in the Office Action. The MPEP requirements have not been met.

REASON 2

A second reason is that the Office Action has not actually shown claim 1 in the applied references. For example, the Office Action breaks claim 1 into two parts, namely,

Part 1, containing lines 1 - 3 and 11 - 15

and

Part 2, containing lines 4 - 10 and 16 and 17.

However, in Part 1, line 12 refers to "**the** one or more role models." There is no antecedent for that phrase in Part 1. Consequently, Part 1 contains a passage which is meaningless.

It is axiomatic that a meaningless statement cannot be shown in the prior art. How can it be proven that the subject matter of the meaningless statement is present in the prior art, when the statement has no meaning ?

As another example of why claim 1 has not been shown in the

applied references, the PTO has not shown why the two parts, when taken together, correspond to claim 1. That is, it is axiomatic that claims are read as-a-whole. The mere presence of two sub-sets of a claim within the prior art does not imply that the two subsets, when assembled into a claim, are also found within the prior art.

Restated, a claim contains (1) elements, (2) relationships among the elements, and (3) perhaps other components. Merely showing that the elements are present in the prior art does not prove that those prior-art elements have the same relationship as recited in the claims. Thus, merely showing Parts 1 and 2 within the prior art (which has not actually been done), is insufficient to show the recited relationship between those Parts.

Therefore, even if Kramer shows Parts 1 and 2, that is insufficient to show claim 1. The PTO has not shown the claimed relationships between Parts 1 and 2. And "the role model" is missing.

REASON 3

A third reason is that the PTO admits that Kramer does not explicitly show Parts 1 and 2 of claim 1, but asserts that Kramer **suggests** Parts 1 and 2. Thus, the PTO is asserting that Kramer **inherently** shows the elements of claim 1.

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the
examiner must provide a basis in fact and/or
technical reasoning to reasonably support the
determination that the allegedly inherent
characteristic <u>necessarily</u> flows from the
teaching of the applied prior art.

The PTO has not followed this MPEP section. The PTO admits
that Kramer fails to explicitly show elements of claim 1, but does
not provide the "basis in fact and/or technical reasoning" required
by this MPEP section to show inherency.

REASON 4

A fourth reason is that the rejection relies on a combination
of Kramer with Walker, but identifies no elements in Walker which
are found in claim 1. In fact, the Office Action fails to discuss
Walker at all, except at the top of page 3.

REASON 5

A fifth reason is that the rejection asserts that it is
obvious to "select" Kramer, and then cites a passage from Kramer
in support of that assertion. That passage merely touts a supposed
benefit of Kramer.

But that is not the test by which obviousness is determined.
And that approach contains meaningless statements.

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-- From what, and on what basis, is Kramer "selected" ? To say that Kramer is "selected," but without saying from what, or on what basis, is meaningless.

Meaningless statements cannot be used in a rejection.

-- Why does Kramer's passage, touting his system, indicate that Kramer should be "selected," over other possibilities. For example, why does Kramer's passage indicate that he should be selected over Boe ?

In addition, Applicant submits that the PTO's statement regarding "selection" is admittedly false, or at least meaningless. The PTO gives reasons why it is obvious to "select" Kramer. But weren't Boe and Walker also "selected" ? Why weren't they obvious to select ? Why is Kramer the only one obvious to "select" ?

The preceding applies to all other claims in this group.

Response to Rejection of Claims 4 and 10

Claims 4 and 10 depend from claims in the group discussed above. Claim 4 recites:

> . . . wherein the step of learning the mapping from the vectors c_k to the vectors i_j comprises using a three-layer neural network to find the mapping function by back propagation.

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<u>Even if References are Combined, Claim 4 is not Found</u>

The Office Action asserts that Boe shows this recitation at four locations:

       1)   Column 4, lines 5 - 25;

       2)   Column 6, lines 58 - 67;

       3)   Column 7, lines 1 - 10; and

       4)   An article identified on the second page

of the "References Cited."

As to location (1), Boe merely refers to a "mapping table" which "may be a relational data structure that provides a correlation between an input and an output." Another location (bottom of column 8) explains what the mapping table does: it can be used to encrypt the customer's identification number.

For example, a copy of the mapping table 30 is given in Sketch 1, below.

```
001 . . . abc
002 . . . def
        ○
30        ○
        ○
        ○
```
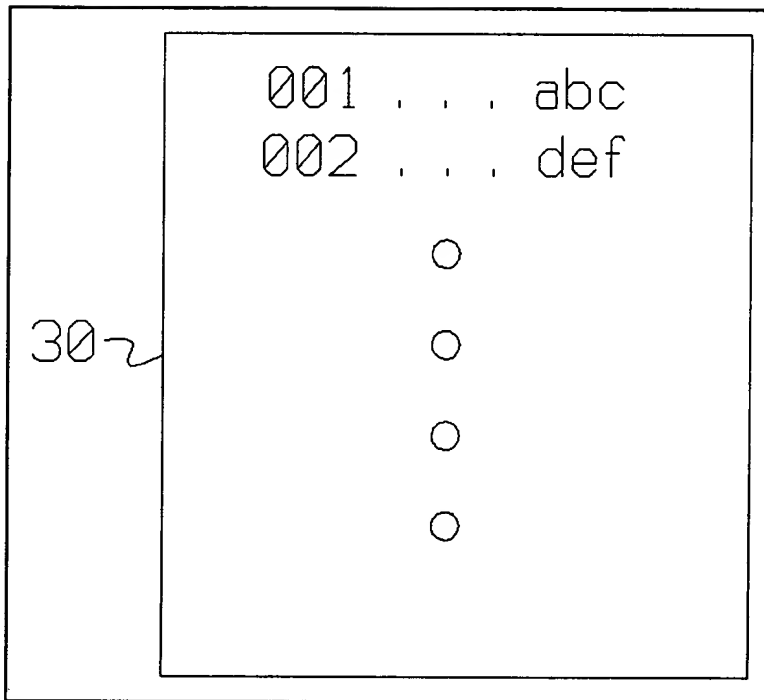
Sketch 1

If the customer's ID number is, for example, 002001, then it would be encrypted into defabc, using the mapping table.

That fails to show the "mapping" of claim 4.

As to location 2, above, it shows nothing relevant to claim 4. Location 2 merely discusses a process of matching attributes of a customer's "demographics" with those in "profiles," in order to select which advertisement to display.

As to location 3, above, it merely discusses a different method of selection than at location 2.

Locations 2 and 3 share the same context. In that context, Boe states that customers are given a demographic profile (eg,

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income, age, sex, etc.) Each customer's profile is compared with

reference profiles, of customers who have purchased, or indicated

a preference for, a certain product. When the customer's profile

matches a reference profile, the product associated with the

reference profile is advertised to the customer. This is the basic

idea expressed at location 2

In addition, Boe's system may choose an advertisement based

on a survey being completed by the customer, rather than on the

demographic profiles exclusively. This appears to be the basic

idea expressed at location 3.

Locations 2 and 3 fail to show the subject matter of claim 4.

As to location 4, that merely identifies a title of an

article. That title does not show the subject matter of claim 4.

Therefore, the subject matter of claim 4 has not been shown

in the applied art. MPEP 2143.03 states:

> To establish <u>prima facie</u> obviousness . . . **all
> the claim limitations** must be taught or
> suggested by the prior art.

In addition, claim 4 is not found in the combination of

references, for another reason. "The step of learning the mapping"

in claim 4 refers to the same step in parent claim 2. That "step

of learning the mapping" refers to a "mapping" which maximizes

sales. That has not been shown in Boe, nor has any factual

evidence been given that shows the "mapping table" in Boe has any

relevance to increasing sales.

No Teaching Given for Combining References I

The rationale given for combining the references relies on a passage taken from Boe (column 1, lines 58 - 65). That passage sets forth a goal of Boe.

It is reasonable to assume that Boe attains the goal which his patent sets forth. Thus, there is no need to combine Boe with Kramer to attain that goal. The goal does not act as a teaching to combine Boe with another reference.

Further, Boe does not appear to state that another reference is needed to attain that goal. Therefore, since Boe, by himself, achieves the goal, there is no reason to combine Boe with Kramer. Thus, Boe's statement does not act as a teaching in favor of combining the references.

Further still, that goal, stated simply, is to obtain data from customers which allows businesses to advertise better. The PTO has shown no **facts** which indicate that applying Boe to Kramer will attain that goal.

No Teaching Given for Combining References II

Applicant respectfully submits that the PTO is mis-interpreting the requirement of a teaching under section 103.

The PTO

(1)   finds a goal articulated in Boe,

(2)   asserts that Kramer-plus-Boe (A) fulfills

that goal, and (B) shows claim 4 and

(3)   concludes that claim 4 is obvious.

However, that is not a teaching under section 103.

The issue is not whether a combination of references fulfills a goal set forth in one of them. The reason is elementary: it is the **EXAMINER** who combined the references. That is, the Examiner found the goal in Boe, and then (supposedly) assembled a system which attains the goal.

That is not a teaching for combining the references. The prior art must teach the technical details on how to attain the combination of elements which show the claim in question.

A goal stated in the prior art, which requires the Examiner to assemble a system to attain the goal, is not a teaching, unless the Examiner can show evidence that assembling the system attaining the goal would be self-evident, given the prompting made by the goal. But the latter showing has not been made. This is clarified in the next section.

Office Action Fails to Comply with Dembiczak

The Office Action does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

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-- **objective evidence** of a teaching for combining references must be provided;

-- the Examiner's speculation does not qualify as objective evidence;

-- numerous sources can provide a teaching to combine references;

-- knowledge of one skilled in the art can act as a source;

-- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;

-- broad conclusory statements by the Examiner do not qualify as evidence; and

-- "particular factual findings" as to the teaching are required, and gives reasons why **facts** are necessary.

In this case, the PTO's approach of

(1) identifying a goal stated by Boe and

(2) combining references to achieve that goal

does not satisfy the requirements of <u>Dembiczak</u>. "Particular factual findings" are required.
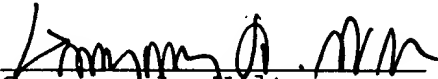
This applies to claim 10.

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Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully   submitted,

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